

REMARKS

Claims 1-47 are pending in the present application. Claims 10, 14, and 39 have been amended. Claims 1, 13, 15, 24, and 41 are independent claims.

Allowable Subject Matter

Applicant appreciatively acknowledges the Examiner's indication that claims 1-9, 11, 12, 15-38, and 40-47 have been allowed.

Rejections Under 35 U.S.C. § 112

Claims 10 and 39 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

As to claim 10, the Examiner points out that the preamble recites, "The one or more computer-readable media of claim 9," even though claim 9 is directed to a "computer-implemented method." Claim 10 has been amended above so that it is now directed to "The computer-implemented method of claim 9." Accordingly, withdrawal of this rejection is respectfully requested.

As to dependent claim 39, the Examiner asserts that this claim is made unclear by the recitation of "a remote second processing device" in independent claim 24. As amended, claim 39 now recites "[t]he kiosk of claim 24, wherein the second processing device is configured to execute image processing software." As amended, Applicants submit that claim 39 is not

inconsistent with independent claim 24. Thus, withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. § 101

Claims 13 and 14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Examiner states that these claims can be interpreted as being directed to a propagated signal. The Examiner asserts that a propagated signal is not recognized by the U.S. Patent and Trademark Office as being patentable subject matter under § 101. See page 3 of the Office Action. This rejection is respectfully traversed.

Initially, Applicant points out that the USPTO has issued Examination Guidelines for Computer-Related Inventions along with a series of Training Materials, which expressly indicate that a “computer data signal embodied on a carrier wave” is a specific article of manufacture and, thus, patentable subject matter under § 101.¹

Furthermore, Applicants submit that statements by the Federal Circuit in a recent court decision strongly supports the position that a computer program embodied on a carrier wave constitutes patentable subject matter. In *Eolas Technologies, Inc. v. Microsoft Corp.*, 73 USPQ2d 1782, 399 F.3d 1325 (Fed. Cir. 2005), the court dealt with the issue of whether software code made in the U.S. and exported abroad on a disk is a component of a patented invention for

¹ See claim 13 in “Examination Guidelines for Computer-Related Inventions, Example: Automated Manufacturing Plant,” available at <http://www.uspto.gov/web/offices/pac/dapp/pdf/compenex.pdf>. Specifically, this document states, “the computer program is embodied on a computer-readable medium--*the carrier wave*. Thus, claim 13 is a statutory article of manufacture” (Claim Analysis – Page 4, emphasis added).

purposes of 35 U.S.C. § 271(f). While not confronted with the issue of patentability under § 101, the court stated that:

“...an invention includes ‘any new and useful process, machine, manufacture, or composition of matter.’ Without question, software code alone qualifies as an invention eligible for patenting under these categories, *at least as processes*” (399 F.3d at 1339; emphasis added).

The court further stated that:

“Exact duplicates of the software code on the [] disk are incorporated as an operating element of the ultimate device. This part of the software code is *much more than* a prototype, mold, or *detailed set of instructions*. This operating element in effect derives the ‘functional nucleus of the finished computer product.’ [] Without this aspect of the patented invention, the invention would not work at all and thus would not even qualify as new and ‘useful.’ Thus, the software code on the [] disk is not only a component, it is probably the *key part* of this patented invention” (*id.*; emphasis added)

Thus, in finding that the computer program code on the disks in *Eolas* was a component of a patented invention under § 271(f), the court placed much emphasis on the fact that an exact copy of that code would ultimately be incorporated into the computer executing the code.

Similar to a disk, a propagated signal embodied on a carrier wave can be used as a medium for copying computer program code into a computer processor. In fact, the *only* way that an exact copy of the computer program code in *Eolas* could be incorporated into the computer device is by propagating signals embodying such code from the disk to the computer device via a carrier wave. Therefore, Applicants respectfully submit that distinguishing computer

programs embodied on a computer-readable disk (which is clearly patentable) from computer programs embodied as computer-readable signals propagated on a carrier wave, for purposes of determining patentability under § 101, runs contrary to the principles espoused by the Federal Circuit.

At least for the reasons presented above, Applicants respectfully submit that claims 13 and 14 are directed to statutory subject matter under § 101. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance. However, should the Examiner believe that any outstanding matters remain in the present application, he is requested to call Jason Rhodes (Reg. No. 47,305) at (703) 208-4011 in order to discuss the application and expedite prosecution.

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Respectfully submitted,

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